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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,026	10/10/2001	Paul P. Tamburini	96-223-ZZ	7892

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EXAMINER

LIU, SAMUEL W

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,026

Applicant(s)

TAMBURINI ET AL.

Examiner

Samuel W Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status of the claims

Claims 12-17 are pending.

Applicants' amendment filed 4 October 2004, which amends claims 12-17 has been entered. Note that claims 1-11 are canceled by Applicants' amendment filed 25 March 2002). The pending claims 12-17 are examined in this Office action.

Note that grounds of objection and/or rejection not explicitly restated and/or set forth below are withdrawn, and that the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, the first paragraph

Claims 12-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 and the claims depending from claim 12 are drawn to an isolated polynucleotide encoding protein fragments comprising SEQ ID NO: 5, or 7 or 8 which are sub-sequences of the full-length sequence of SEQ ID NO:52. The full-length sequence has activities, e.g., trypsin or human plasma kallikrein. However, the specification does not teach or describe that the protein fragment of SEQ ID NO: 5, or 7 or 8 has assayable activity or the activity of the

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said full-length sequence of SEQ ID NO:52 thereof. Therefore, the specification lacks written description for these limitations regarding the SEQ ID NO: 5, or 7 or 8 sequence.

Appellants may wish to amend the claims (under 35 USC 112) to additionally list a specific, measurable activity or function that these fragments must have so that one skilled in the art can recognize when they are in possession of a polynucleotide encoding a polypeptide having SEQ ID NO:5 or 7 or 8, and having a specific function.

The Applicants' response to the rejection under 35 USC 112, the 1st paragraph

At pages 11-12, the response filed 4 October 2004 argues that although the current application does not describe biological function of the said protein fragments, the parental Application No. 09/144428 (now US Pat. No. 6583108), has taught the function thereof for the protein fragments having SEQ ID NOs: 5, 7 and 8. The applicant's argument is found to be not persuasive because the biological function of the protein fragments that are encoded by the claimed polynucleotides must be described in the instant application in such a way that it is clear that the applicant invented what is claimed, and thus, and thus fulfills the written description criteria.

It is of note that the current application is a *continuation* application of 09/144428 which has taught activity of the SEQ ID NOs: 5, 7 and 8 polypeptides but not in the specification of the instant application. The burden is now on Applicants to explain this inconsistency between these continuation applications.

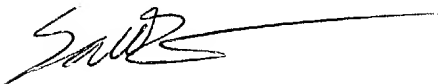
Conclusion

No claims are allowed.

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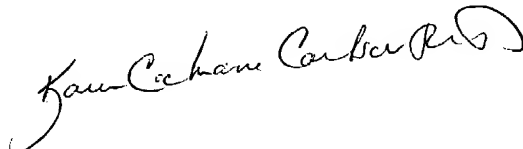
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu whose telephone number is 571-272-0949. The examiner can normally be reached from 9:00 a.m. to 5:30 p.m. on weekdays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4242 or 703 872-9306 (official) or 703 872-9307 (after final). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Samuel Wei Liu, Ph.D.

November 2, 2004



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER